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09/474,216	12/29/1999	OLEG B. RASHKOVSKIY	INTL-0319-US	2005

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EXAMINER

NALEVANKO, CHRISTOPHER R

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/474,216

Applicant(s)

RASHKOVSKIY, OLEG B.

Examiner

Christopher R. Nalevanko

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 60, 61, 63-67 and 69-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60, 61, 63-67, 69-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/22/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The Applicant's prior response regarding inventorship is not sufficient. As stated in the MPEP section 2137, the Applicant is required to supply a 37 CFR 1.132 affidavit to clear up any confusion regarding the prior inventor.

Claims 60-88 are directed to the same invention as that of claims 1-24 of commonly assigned Patent Application 09/196,262. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

As noted before, failure to comply with this requirement will result in a holding of abandonment of this application.

### ***Response to Arguments***

1. Applicant's arguments filed 12/27/2004 have been fully considered but they are not persuasive.

Regarding Claim 60, Applicant argues that "neither Menard nor Akiba specifically disclose displaying one video transmission while monitoring and storing another video transmission" (page 7 lines 10-13). Examiner asserts that Menard clearly

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describes monitoring and storing multiple video streams and alerting a user when a predetermined option (page 11 lines 29-33, monitoring streams and alerting when interest is detected, page 13 lines 14-19, storing detected video stream, page 17 lines 29-31, monitoring and watching multiple video channels simultaneously). Although suggested by Menard (see fig. 12, video window), Menard fails to specifically state storing one video transmission while tuning to another. Akiba shows the ability to tune to one video transmission while storing another transmission and tuning to two different video channels (col. 1 lines 60-67, col. 2 lines 1-30, col. 3 lines 45-62, col. 4 lines 10-25, figs. 5-9, capable of simultaneously recording and reproducing a video signal from a recording medium and reproducing video signals of two channels). Since Menard shows the ability to simultaneously “watch” two video streams, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Menard with the ability to store and tune multiple video transmissions as in Akiba so that a user could watch one program while simultaneously recording another.

Applicants arguments regarding the “automatically switching from the display of one video transmission to display of a different video transmission” are moot in light of new rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 60, 61, 63-67, 69-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menard et al (WO 96/27840) in further view of Akiba et al (6,542,695) and De Saint Marc (EP 0912053).

Regarding Claim 60, Menard shows a method comprising storing a user-selected option on a receiver, the option associated with an event in a video transmission (page 3 lines 1-13, 22-31) and monitoring and storing one video transmission on the receiver, the monitoring to detect the event (col. 3 lines 6-13, 22-31, page 4 lines 13-19, page 8 lines 14-31, page 9 lines 1-7, monitoring system that stores a designated data stream). Menard also shows, in response to detecting the event, displaying the transmission from a predetermined time before the occurrence of the event (page 9 lines 1-7, page 11 lines 5-13, page 13 lines 20-22, page 15 lines 17-27, page 16 lines 13-24, delay system for recording a predetermined time before the event, sending the delayed feed to the live display). Menard further shows the ability to tune to a video transmission (page 8 lines 6-14). Menard fails to show the ability of storing one video transmission while tuning to display another. Akiba shows the ability to tune to display one video transmission while storing another transmission (col. 1 lines 60-67, col. 2 lines 1-30, col. 3 lines 45-62, col. 4 lines 10-25, figs. 5-9, simultaneously viewing and reproducing). Since Menard shows the ability to simultaneously "watch" two video streams, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Menard with the

ability to store and tune multiple video transmissions as in Akiba so that a user could watch one program while simultaneously recording another.

Although Menard shows the ability to alert a user with a video window when a identified streams has been matched (page 10 lines 10-16, opening up video window when keyword found, page 13 lines 20-23), both Menard and Akiba fail to specifically state that the alerted stream is automatically switched from the display of the another video transmission to display the one video transmission. De Saint Marc clearly shows completely and automatically switching from one video transmission to another when a predetermined event that is being monitored is received (col. 3 section 0016, automatically change channels to a channel where a goal has occurred). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Menard and Akiba with the complete, automatic channel switching of De Saint Marc so that the system would quickly change channels and the user would not miss an important event.

Regarding Claim 61, Akiba shows displaying another video transmission in a portion of the display screen while displaying the one video transmission (figs. 5-9, col. 4 lines 10-52, col. 5 lines 1-2).

Regarding Claim 63, Akiba shows the ability to store multiple video transmissions at the same time while viewing them (figs. 5-9, col. 4 lines 10-52, col. 5 lines 1-2).

Regarding Claim 64, Menard shows storing a plurality of options, each associated with different events (page 9 lines 11-33, page 10 lines 1-5, page 12 lines 4-8).

Regarding Claim 65, Akiba shows storing a plurality of video transmissions at the same time (figs. 5-9, col. 4 lines 10-52, col. 5 lines 1-2). Menard shows storing a plurality of monitored video transmissions (page 17 lines 15-29).

Regarding Claim 66, Menard shows a delay unit, that is user configurable, to record time before the event (page 9 lines 1-7, page 11 lines 5-13, page 15 lines 18-28).

Regarding Claim 67, Menard shows the ability to automatically show the detected event when detected (page 13 lines 20-22, page 16 lines 13-24, page 17 lines 22-29, automatically displaying the alerted stream).

Regarding Claim 69, Akiba shows storing one video transmission while displaying another (col. 1 lines 60-67, col. 2 lines 1-30, col. 3 lines 45-62, col. 4 lines 10-25, figs. 5-90). Menard shows monitoring a video transmission while storing it (col. 3 lines 6-13, 22-31, page 4 lines 13-19, page 8 lines 14-31, page 9 lines 1-7, monitoring system that stores a designated data stream).

Regarding Claim 70, Menard shows displaying the stored video transmission from a time before to a time after the event (page 9 lines 1-7, page 11 lines 5-13, page 15 lines 18-28).

Regarding Claim 71, Menard shows that the user defines the time to be shown before the event (page 9 lines 1-7, page 11 lines 5-13, page 15 lines 18-28).

Regarding Claim 72, Menard shows an article comprising a medium storing instructions, enabling a processor based system to execute (page 5 lines 27-32, page 6 lines 1-10, figs. 1 and 2). Furthermore, Mendard shows the ability to simultaneously receive two video transmissions on the receiver (page 17 lines 29-31, monitoring and

watching multiple video channels simultaneously). All other limitations have been discussed with regards to Claim 60.

Regarding Claims 73-83, the limitations of the claims have been discussed with regards to Claims 61-71, respectively.

Regarding Claim 84, the limitations of the claim have been discussed with regards to Claim 71.

Regarding Claim 85, Menard shows a television system coupled to the receiver (fig. 1 item 4).

Regarding Claim 86, Menard shows the use of a keyboard (fig. 8 item 29). Both Menard and Akiba fail to show using a remote control. Official Notice is given that it is well known and expected in the art to use a remote control. This allows a user to conveniently control the receiver operation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made with the ability to use a remote control so the user would have a convenient method of control.

Regarding Claim 87, Menard shows a monitor (fig. 1 item 8).

Regarding Claim 88, Menard shows a set-top box (fig. 1 "tuner").

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**



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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Nalevanko whose telephone number is 571-272-7299. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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